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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,416	10/22/2003	Patrick W. Kelley	PWK-02-1-D	6171

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EXAMINER

SPEER, TIMOTHY M

ART UNIT PAPER NUMBER

1775

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,416

Applicant(s)

KELLEY, PATRICK W.

Examiner

Timothy M. Speer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/08/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christian (USPN 5,253,458) in view of Bonnema (USPN 4,913,473).**

Christian teaches simulated logs formed from a pipe made of PVC (polyvinyl chloride) (See abstract and col. 3, lines 31-38). Christian further teaches that the pipes are pre-cast with a simulated log design to include knots, cracks and wood grains (e.g. having a diameter deviation). Christian fails to teach that the log is made of at least 80% thermoplastics comprising at least one of polyethylene or polypropylene and is silent on the diameter and length of the simulated log.

Bonnema teaches a large diameter molded plastic pipe which may be made of high-density polyethylene, PVC or polypropylene (col. 8, lines 46-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention, to substitute polypropylene or polyethylene thermoplastics that are disclosed in Bonnema for the PVC used in the simulated log taught by Christian since the reference specifically teaches that polypropylene or polyethylene may be substituted for PVC as a suitable material for making plastic pipes and because the Christian reference discloses that such plastic pipes are used to make the simulated logs.

With respect to the claimed diameter deviation, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See MPEP 2144.04. In the present case, the diameter deviation serve no mechanical functions, but are related to merely aesthetic purposes. Accordingly, this limitation is not seen to distinguish over the applied prior art.

Although Christian does not specifically disclose the claimed diameter or length of the simulated log, absent a showing of criticality, it would have been obvious to a person of ordinary skill in the art at the time of the invention to optimize the length and diameter (result effective variables) through routine experimentation. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). With regard to the claimed properties, it expected that the disclosed materials would exhibit these properties, since they are the same materials as claimed by applicant.

3. Claims 1 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christian in view of Erwin (USPN 5,728,330).

Christian was discussed above and fails to teach that the log is made of at least 80% thermoplastics comprising at least one of polyethylene or polypropylene and is silent on the diameter and length of the simulated log.

Erwin teaches simulated wood products comprising polyethylene, PVC or polypropylene outer layers (col. 4, lines 55-61). That is, Erwin teaches the functional equivalence of polyethylene, polypropylene and PVC in the manufacture of simulated wood products.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention, to substitute polypropylene or polyethylene thermoplastics that are disclosed in Erwin for the PVC used in the simulated log taught by Christian, since the reference specifically teaches that polypropylene or polyethylene may be substituted for PVC as a suitable material for simulated wood products, such as those disclosed by Christian.

With respect to the claimed diameter deviation, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See MPEP 2144.04. In the present case, the diameter deviation serve no mechanical functions, but are related to merely aesthetic purposes. Accordingly, this limitation is not seen to distinguish over the applied prior art.

Although Christian does not specifically disclose the claimed diameter or length of the simulated log, absent a showing of criticality, it would have been obvious to a person of ordinary skill in the art at the time of the invention to optimize the length and diameter (result effective variables) through routine experimentation. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). With regard to the claimed properties, it expected that the disclosed materials would exhibit these properties, since they are the same materials as claimed by applicant.

4. Claims 1 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin.

Erwin teaches simulated wood products. The articles of Erwin comprise an outer polymer shell, wherein the polymer layer may be selected from polymers including polyethylene

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and polypropylene (abstract and col. 4, lines 55-61, for instance). Moreover, the polymer shell may comprise a mixture of these material and additional polymeric components. Therefore, it would have been obvious to one having ordinary skill in the art to form the product of Erwin from polyethylene, polypropylene or mixtures including these materials, as presently claimed, since Erwin suggests such materials. That being done, the recited flexural modulus would be inherent in the resulting product, since the product would be made from the same material as presently claimed.

With respect to the claimed diameter deviation, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See MPEP 2144.04. In the present case, the diameter deviation serve no mechanical functions, but are related to merely aesthetic purposes. Accordingly, this limitation is not seen to distinguish over the applied prior art.

Although Erwin does not specifically disclose the claimed diameter or length of the simulated products, absent a showing of criticality, it would have been obvious to a person of ordinary skill in the art at the time of the invention to optimize the length and diameter (result effective variables) through routine experimentation. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

5. Applicant's arguments filed 09/08/06 have been fully considered but they are not persuasive.

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6. Applicant argues that the claimed "diameter deviation" is more than mere ornamentation, asserting that "diameter deviation does serve a function in that it defines a plastic log." This is not persuasive. Such function is clearly simply decorative and as noted in the previous Office Action, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See MPEP 2144.04. The Examiner maintains his position.

7. Next, applicant argues that there is not suggestion in Bonnema that polypropylene or polyethylene would provide better performance in a plastic log, asserting that there must be some disclosure in Bonnema that these materials would be superior to PVC. Clearly, this is not the case. As noted above, the prior art teaches the functional equivalence of polypropylene, polyethylene and PVC. Accordingly, to employ these materials is prima facie obvious. There need be no teaching of superiority of the materials, only that they are equivalents in the art. Applicant makes essentially the same argument with respect to Christian in view of Erwin. This argument is not persuasive for reasons discussed above.

8. Next applicant argues that Erwin fails to teach the claimed diameter. As noted above, diameter is a parameter easily optimized by one having ordinary skill in the art, and to do so would have been obvious to that person. Moreover, applicant is arguing the thickness of the material rather than the diameter of the structure. This is not persuasive.

9. Applicant also argues that the prior art fails to teach "monolithic" plastic logs. This is not persuasive, since the present claims are not directed to such embodiments. It is not persuasive to argue limitations which are not in the claims.

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10. Finally, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present case, the Examiner relies only on knowledge gleaned from the prior art in reaching a determination of obviousness. It is the teaching of the equivalence of PVC with PE and PP as taught in Bonnema upon which this determination resides and not any teaching gleaned from applicant's disclosure.

11. In light of the above, applicant's arguments have been fully considered but are not found to be persuasive.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385.

The examiner can normally be reached on M-Th, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Timothy M. Speer


JENNIFER MCNEIL
SUPERVISORY PATENT EXAMINER
11/27/06